DETAILED ACTION

Response to Arguments

Applicant's arguments filed 04 January 2010 have been fully considered but they are not persuasive. Claims 1-4, 6-9, 11, 15-20 are pending. In regards to the prior art Weitkamp and Boyer, Applicant continues to argue that the 103(a) combination made would not have been obvious since both Weitkamp and Boyer disclose complete lifting systems. The Examiner respectfully disagrees with this assertion. The Examiner points out the completeness of the inventions disclosed in the prior art has no bearing on rejections made in the previous Office Action. Particularly, the prior art in a 103(a) situation provides teaches showing the state of the art at the time the invention was made. In the instant application, Boyer clearly shows that providing a winch on a vehicle is already known in the lifting art and the Examiner is combining the known winch with a known use. This is the essence of obviousness and thus a proper 103(a) rejection. Applicant cites MPEP 2141.02 (VI) to support that the prior art are must be considered in its entirety and thus each reference must be considered as a complete system. The Examiner points out however that MPEP 2141.02 (VI) also states,

"the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Furthermore MPEP 2123 states:

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature

of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also > Upsher-Smith Labs. v. Pamlab, LLC, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005)(reference disclosing optional inclusion of a particular component teaches compositions that both do and do not contain that component);< Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

While Weitkamp and Boyer may teach complete systems they also show the state of the art and thus relevant to the claimed invention. Furthermore, Boyer clearly reasonably suggests to one of ordinary skill in the art that a winch can be attached to a vehicle. Applicant appears to be making the argument that Applicant has discovered attaching a wench to a vehicle which is clearly not the case. Further, it is clearly not the case that using a wench on a wind turbine installation is new and novel in the art. Applicant is essentially attempting to patent a system and method that has been repeatedly shown to be obvious to one of ordinary skill in the art and is fundamentally swapping a crane with a winch to perform the assembly of the wind turbine installation. Applicant only substantive argument is that the prior art showing all of the claimed

subject matter can not be combined because they are complete systems and thus there is no motivation to combine. As clearly refuted above, this line of reasoning is flawed and does not comport with the current understanding of 35 USC 103(a) as motivation as been clearly provided by the Examiner without the use of Applicant's disclosure.

In regards to the passage of Applicant's disclosure cited by the Examiner, it is noted that the Examiner states that Applicant admits that is it is well known in the art to transport a winch to installation for raising and lowering components. Unless the Examiner is missing something, the winch must be transport only with the other components of the wind turbine assembly to the site by a vehicle. This passage lends support to the Examiner's assertion that the prior art lifting systems cited herein are known to one of ordinary skill in the art as the winch cannot get to the installation site any other way.

In regards to prior art Jackson, Applicant argues that Jackson would be incapable of lifting components of a wind turbine; however this is not the essences of the rejection made. Jackson clearly teaches that a winch can be transported on a vehicle, whether or not the vehicle can with stand the forces irrelevant since Applicant has not made any specific requirements for the vehicle other than it being a transport vehicle. Therefore, the Examiner has maintained all of the previously indicated rejections.

With respect to the rejection of claim 16 under 35 USC 112 1st paragraph address the negative limitation of the crane separate from the pylon not being used to support the wench, Applicant argues that the burden is on the Examiner to present evidence or reasons why one of skill in the art would not recognize that the written description provides support for the claims. Applicant also notes that there is a strong presumption that the specification contains an adequate

disclosure as filed. This is in reference to the original claims as filed, not limitations added in during prosecution. Moreover, it is the burden of Applicant to show that any new limitation is supported by the specification and in this case, Applicant's cited passage does not discuss attaching or not attaching a winch to a crane, but does disclose not using a crane at all. Therefore, the negative limitation is not clearly support by the specification as indicated in the rejection and is thus maintained.

Since the other rejections have been argued in the same manner as Weitkamp and Boyer, the Examiner maintains the position set forth above. Claim 20 has been treated below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weitkamp (EP-1101934 A) in view of Boyer (6,494,437). Weitkamp discloses a wind power installation ("installation") 10 comprising a pylon 14 having a pod 18; a winch 60; a base 12; at least one deflection roller 64 and at least one rope passage 50 in the region of the pylon head for passing through a hauling cable from the winch. Weitkamp further discloses a second cable passage means (See passage for cable 62) disposed above the pylon head and configured to raise and lower components of the installation within the pylon. The Examiner notes that the winch is

also located within the pylon and the pylon is a hollow shaft. Weitkamp does not disclose the winch being located outside the pylon mounted on a transport vehicle.

Boyer teaches a winch being mounted on a transport vehicle. The Examiner also notes that Applicant states in the Background of the Invention that it is well known in the art to transport a winch to installation for raising and lowering components. Therefore, it is the position of the Examiner that it would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the winch on a transport vehicle as taught by Boyer for the purpose of installing components of a wind power installation. In regards to method claims 6 and 7 the combination of Weitkamp and Boyer as disclosed above would be inherently capable of performing the method as claimed.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weitkamp (EP-1101934 A) in view of Jackson (3,829,064). Weitkamp discloses a wind power installation ("installation") 10 comprising a pylon 14 having a pod 18; a winch 60; a base 12; at least one deflection roller 64 and at least one rope passage 50 in the region of the pylon head for passing through a hauling cable from the winch. Weitkamp further discloses a second cable passage means (See passage for cable 62) disposed above the pylon head and configured to raise and lower components of the installation within the pylon. The Examiner notes that the winch is also located within the pylon and the pylon is a hollow shaft. Weitkamp does not disclose the winch being located outside the pylon mounted on a transport vehicle.

Jackson teaches a winch system being mounted on a transport vehicle. The Examiner also notes that Applicant states in the Background of the Invention that it is well known in the art to transport a winch to installation for raising and lowering components. Therefore, it is the

position of the Examiner that it would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the winch on a transport vehicle as taught by Jackson for the purpose of installing components of a wind power installation. In regards to method claims 6 and 7 the combination of Weitkamp and Jackson as disclosed above would be inherently capable of performing the method as claimed.

Claims 8, 9, 11 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nickelsen (EP 1101936 A2) in view of Boyer (6,494,437). Nickelsen discloses a wind power installation comprising: a pylon (not labeled); a base; a pod (referred to as the nacelle); a winch 31; a cable guide 35; a blade opening 33; and a cable 32 coupled to the winch wherein the winch may be located within the rear of the housing. Nickelsen further shows in Figure 7 shows the cable 32 passes through the opening 34 in the pod and a second opening in the pod (the second opening being the opening for the blade which also acts as a second cable guide. Nickelsen does not disclose the winch being located outside the pylon mounted on a transport vehicle.

Boyer teaches a winch being mounted on a transport vehicle. The Examiner also notes that Applicant states in the Background of the Invention that it is well known in the art to transport a winch to installation for raising and lowering components. Therefore, it is the position of the Examiner that it would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the winch on a transport vehicle as taught by Boyer for the purpose of installing components of a wind power installation. In regards to method claims 6 and 7 the combination of Nickelsen and Boyer as disclosed above would be inherently capable of performing the method as claimed.

In regards to claim 16, the Examiner notes that the host vehicle for the winch is not a crane.

With respect to claim 20, since the winch of Boyer is used to lift heavy components with out the use of a crane (as the vehicle is not a crane), and winch is inherently capable of lifting and lowering heavy components, it is clear that the combination of Nickelsen and Boyer meets all of the structural limitations as set forth herein.

Claims 8, 9, 11 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nickelsen (EP 1101936 A2) in view of Jackson (3,829,064). Nickelsen discloses a wind power installation comprising: a pylon (not labeled); a base; a pod (referred to as the nacelle); a winch 31; a cable guide 35; a blade opening 33; and a cable 32 coupled to the winch wherein the winch may be located within the rear of the housing. Nickelsen further shows in Figure 7 shows the cable 32 passes through the opening 34 in the pod and a second opening in the pod (the second opening being the opening for the blade which also acts as second cable guide). Nickelsen does not disclose the winch being located outside the pylon mounted on a transport vehicle.

Jackson teaches a winch system being mounted on a transport vehicle that is not a crane. The Examiner also notes that Applicant states in the Background of the Invention that it is well known in the art to transport a winch to installation for raising and lowering components. Therefore, it is the position of the Examiner that it would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the winch on a transport vehicle as taught by Jackson for the purpose of installing components of a wind power installation. In regards to method claims 6 and 7 the combination of Nickelsen and Jackson as disclosed above would be inherently capable of performing the method as claimed.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 16 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the limitation of "a crane separate from the pylon is not used to support the winch" is not support by the original specification as filed and is therefore considered new matter.

CONCLUSION

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWAYNE J. WHITE whose telephone number is (571)272-4825. The examiner can normally be reached on 7:00 am to 3:30 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Look can be reached on (571) 272-4820. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dwayne J White/
Examiner, Art Unit 3745

DJW